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09/655,054	09/05/2000	John L. Shannon JR.	122.1.1/USA	7269

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EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/12/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.



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GROUP 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/655,054
Filing Date: September 05, 2000
Appellant(s): SHANNON, JOHN L.

James W. Miller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 10, 2003.

(1) *Real Party in Interest*

Art Unit: 3711

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct, except that the rejection of claims 27-32 under 35 USC 102 as anticipated by Miller is hereby withdrawn, thereby removing this rejection is an issue.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 27-34 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Art Unit: 3711

4,976,432	Cheney	12-1990
5,352,057	Zody	10-1994

(10) Grounds of Rejection

As noted above, the examiner has withdrawn the 102 rejection based upon Miller (USPN 5665038). The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheney (USPN 4976432) in view of Zody (USPN 5352057).

Cheney discloses a sectional and height adjustable singles stick, in which sections are combined in order to achieve the desired and specifically claimed height for holding up a tennis net (See Abstract). The sections are connected by inserting the dowel end of a section into the hollow bottom end of another section (which is inherently a telescoping motion) to achieve compact storage (See Column 7, lines 50 through 68; and Column 8, lines 1 through 37). Cheney also suggests that the dowels (22) may be

Art Unit: 3711

constructed of any suitable material, shape, and size, which would imply that having a non circular shape would accomplish the same end as the circular shape (See Column 7, lines 33 through 67). Therefore, it would have been obvious in view of the explicit suggestion in the reference for choice to one having ordinary skill in the art to have selected any shaped dowels, such as non-circular, for facilitating the connection of the dowels and for avoiding pinching of the user. Cheney also discloses that the device may be stored within a player's equipment tote bag (See Column 2, lines 35 through 41). It is also noted that the device has a slot (10) for receiving any width net band wherein the slot has holes (16) which receive a peg (12) for adjusting the height of the net (See Column 2, lines 42 through 59). It is clearly evident that removing the holes of Cheney would remove the function of the net being adjustable. Cheney does not disclose length adjustment by a telescoping motion nor a locking pin for holding the present invention in place. Zody discloses that length adjustment by a telescoping motion and biased detent locking mechanisms are commonly known within the sports equipment art for supporting adjustable, telescoping members in a desired position (See Background of the Invention). As seen in Figure 5 of Zody, the locking mechanism (16), which is primarily connected to the inner telescoping member (12), is spring biased such that the lock automatically sets into the next available position (Also See Column 67 through 65). Removing a number of locking positions would prevent the device from being adjustable. When comparing Cheney and Zody, it would appear that making the singles stick of Cheney telescoping in the manner taught by Zody is nothing more than substitution of adjustment mechanisms known to be equivalents within the art;

Art Unit: 3711

therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the invention of Cheney telescoping as taught by Zody in order to facilitate assembly and storage. It also would have been obvious to one having ordinary skill in the art at the time of the invention to utilize a biased or manually removable locking mechanism as taught by Zody in order to support the structure of Cheney in a desired position.

(11) Response to Argument

The appellant argues that the combination of Cheney in view of Zody fails to establish *prima-facie* obviousness because Cheney does not teach the device being telescoping, does not teach the notch for holding the net to be fixed, and Cheney and Zody does not teach a single predetermined extended locked position. The examiner respectfully disagrees.

Cheney is inherently teaching telescoping to some extent. Merriam-Webster's Collegiate Dictionary defines telescoping as "to become forced together lengthwise with one part entering another as a result of collision." The claims of the appellant do not require the staff to telescope within the base such that the entire body of the staff is within the base. The dowels of Cheney are forced into an end of a section wherein the sides of the dowel and section collide. Base on what is defined as telescoping, Cheney meets the limitation. But the express teaching of telescoping for adjustability comes from Zody, not Cheney.

Cheney does teach a fixed notch for holding the net, in addition to a fine adjustment mechanism. Omission of an element and its function is obvious if the

Art Unit: 3711

function of the element is not desired (See *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)). Removing the holes and peg for the invention of Cheney would clearly remove the net adjustability function.


The arguments that Zody does not teach a single predetermined extended locked position, is not persuasive. Having more than one locking position allows the device to be adjustable. As noted above, *In re Larson* and *In re Kuhle* applies to this situation. Removing a number of locking positions from Zody would leave the invention without the ability to be adjustable, an obvious matter of whether the user desires this feature, clearly within the level of skill of the workman in the art. Furthermore, Zody was used to teach the locking mechanism and not the locking positions.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

September 10, 2003

Conferees



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Group 3700

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheney (USPN 4976432) in view of Desmond et al. (USPN 4718671) and OFFICAL NOTICE.

Cheney discloses a sectional and height adjustable singles stick, in which sections are combined in order to achieve the desired height for holding up a tennis net (See Abstract). The sections are connected by inserting the dowel end of a section into the hollow bottom end of another section (See Column 7, lines 50 through 68; and Column 8, lines 1 through 37). It also suggests that the dowels (22) may be constructed of any suitable material, shape, and size (See Column 7, lines 33 through 67). Clearly, Cheney accomplishes that of the telescoping feature within the present application and would be merely an equivalent means for making the device portable (See MPEP 2144.04 Section V). If in doubt, Desmond discloses a telescoping cue stick with a locking mechanism to keep the telescoping sections from during use, which the central section (102) is telescopically received within the butt section (101) (See Abstract). Desmond et al. accomplishes making the cue stick portable and adjustable for transportation, storage, and to accommodate various users (See Background of the

Art Unit: 3711

Invention). Cheney does not have any support and still accomplishes that of the present invention, which is to hold a tennis net at a desired height; therefore, it would appear that a base is not critical for the invention to accomplish its goal.

OFFICIAL NOTICE is taken that a telescoping device would need some sort of locking system, such as a spring-biased push pin or pull pin and slot system, screw and slot system, etc. Examples of devices that uses such systems are adjustable crutches, seats used for exercise devices, etc.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any sort of locking system to for a telescoping unit in order to hold the unit in the desired position and preventing it from collapsing during its use.

2. Claims 11-14 and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheney (USPN 4976432) in view of Desmond et al. (USPN 4718671), Stearns (USPN 6152859), and OFFICIAL NOTICE.

Cheney discloses a sectional and height adjustable singles stick, in which sections are combined in order to achieve the desired height for holding up a tennis net (See Abstract). The sections are connected by inserting the dowel end of a section into the hollow bottom end of another section (See Column 7, lines 50 through 68; and Column 8, lines 1 through 37). It also suggests that the dowels (22) may be constructed of any suitable material, shape, and size (See Column 7, lines 33 through 67). Clearly, Cheney accomplishes that of the telescoping feature within the present application and would be merely an equivalent means for making the device portable (See MPEP 2144.04 Section V). If in doubt, Desmond discloses a telescoping cue stick with a

Art Unit: 3711

locking mechanism to keep the telescoping sections from during use, which the central section (102) is telescopically received within the butt section (101) (See Abstract).

Desmond et al. accomplishes making the cue stick portable and adjustable for transportation, storage, and to accommodate various users (See Background of the Invention). Cheney does not have any support and still accomplishes that of the present invention, which is to hold a tennis net at a desired height; therefore, it would appear that a base is not critical for the invention to accomplish its goal. Stearns discloses an exercise apparatus, which has a spring loaded pin (136) engaging a plurality of holes for locking a frame member (110) within a desired position along the post (120) (See Column 5, lines 38 through 56). The frame and post are oriented in a vertical position and, therefore, teaches the purpose for using a system of such. Stearns also notes that any other suitable locking systems may be used; therefore, one having ordinary skill in the art would consider a spring finger as of that disclosed by the applicant as being a substitution for locking two elements together.

OFFICIAL NOTICE is taken that a majority of spring are made of metallic material and that the stiffness of the material depends on the force required for the application that it is being applied to (Hooke's Law). One having ordinary skill in the art would see the use of a flexible metallic material being nothing more than a design choice.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any sort of locking system to for a telescoping unit in order to hold the unit in the desired position and preventing it from collapsing

Art Unit: 3711

during its use. It also would have been obvious to have a metallic biasing material as a mere design choice for the purpose of biasing the locking pin back into position when it lines up within the desired slot.

Response to Arguments

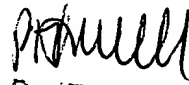
Applicant's arguments with respect to claims 1-8, 10-14, and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Paul T. Sewell
Supervisory Patent Examiner
Group 3700